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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,103	04/16/2004	Hitoshi Saito	SON-3000	7692
23353 7590 01/23/2008 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			EXAMINER RENNER, CRAIG A	
			ART UNIT 2627	PAPER NUMBER
			MAIL DATE 01/23/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/825,103	Applicant(s) SAITO ET AL.	
	Examiner Craig A. Renner	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>05 September 2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 November 2007 has been entered.

### ***Election/Restrictions***

2. Claims 3 and 5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to one or more non-elected inventions/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 17 January 2007.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 05 September 2007 is in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

***Specification***

4. The disclosure is objected to because of the following informalities:

- a. In line 8 of claim 2, "said shorter side members" should be changed to --said shorter-side members-- in order to more clearly refer back to that set forth in line 5 of claim 2.
- b. In lines 8-9 of claim 4, "said longer side members" should be changed to --said longer-side members-- in order to more clearly refer back to that set forth in line 4 of claim 4.
- c. In line 3 of claim 6, "has" should be deleted for better clarity.
- d. In lines 6-7 of claim 6, "said longer side members" should be changed to --said longer-side members-- in order to more clearly refer back to that set forth in line 3 of claim 6.
- e. In lines 2-3 of claim 7, "said one of first engaging piece and first engaging groove" should be changed to --said one of said first engaging piece and said first engaging groove-- for better clarity.
- f. In line 8 of claim 8, "said shorter side members" should be changed to --said shorter-side members-- in order to more clearly refer back to that set forth in line 5 of claim 8.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 2, 4, and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In line 3 of claim 1, "side faces substantially parallel to a recording surface of an inserted disk" is indefinite as it is misdescriptive of the disclosure, which teaches/shows that the upper face **3e** is substantially parallel to a recording surface **21a** of an inserted disk **20**.

b. In line 3 of claim 1, "a decorative panel covering approximately the entire surface of the side faces" is indefinite as it is misdescriptive of the disclosure, which teaches/shows the decorative panel **2** covering substantially the entire surface of upper face **3e**.

c. Many elements in the claims are indefinite because they lack clear and/or positive antecedent basis including "said shorter-side engagement members" (line 3 of claim 4), "the longer-side engagement members" (line 8 of claim 6), and "the shorter-side engagement members" (line 9 of claim 6).

d. In line 5 of claim 7, it is indefinite as to which of the "shorter-side members," set forth in line 5 of base claim 2, is being referenced by "said shorter-side member."

e. Claims 2 and 8 inherit the indefiniteness associated with independent claim 1 and stand rejected as well.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

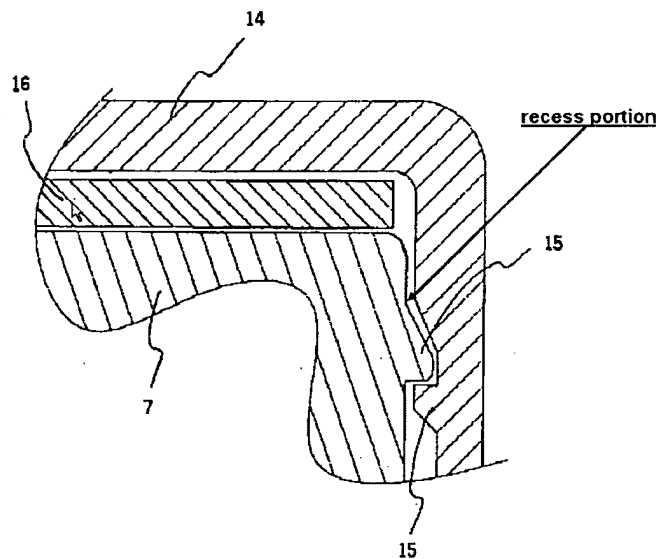
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujihata et al. (JP 2001-125667).

Fujihata et al. (JP 2001-125667) teaches a disk drive apparatus comprising a disk drive body (includes 7) including a front face having an insertion opening (12) for a disk (i.e., such as a hard disk PCMCIA card) and faces substantially parallel to a recording surface of an inserted disk; and a decorative panel (14) covering approximately the entire surface of the faces and being disposed so as to be detachable from the side faces (as shown in FIGS. 2 and 3, for instance) [as per claim 1]; wherein the decorative panel comprises a flat panel portion (14) shaped as a rectangle by having a periphery thereof with longer-sides and shorter-sides (as shown in FIG. 4, for instance); shorter-side members disposed along the shorter-sides of the flat panel portion (as shown in FIG. 3, for instance); and at least one shorter-side engagement member (15) comprising one of a first engaging piece and a first engaging groove (i.e.,

in this case, a first engaging piece) provided at the shorter-side members for engagement with the disk drive body (as shown in FIGS. 2 and 3, for instance) [as per claim 2]; wherein the disk drive body is disposed in the vicinity of the one of the first engaging piece and the first engaging groove in a state in which the decorative panel is installed on the disk drive body (as shown in FIGS. 2 and 3, for instance), and the disk drive body has a recess portion (as shown below, for instance) disposed so as to oppose to the shorter-side member;



and wherein the decorative panel comprises a flat panel portion (14) shaped as a rectangle by having a periphery thereof with longer-sides and shorter-sides (as shown in FIG. 4, for instance); shorter-side members disposed along the shorter-sides of the flat panel portion (as shown in FIG. 3, for instance); and at least one shorter-side engagement member (15) comprising one of a first engaging piece and a first engaging groove (i.e., in this case, a first engaging piece) provided at the shorter side members

mechanically interlocked with the disk drive body (as shown in FIGS. 2 and 3, for instance) [as per claim 8].

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujihata et al. (JP 2001-125667).

Fujihata et al. (JP 2001-125667) teaches the disk drive apparatus as detailed in paragraph 8, supra, further wherein the decorative panel further comprises a plurality of shorter-side engagement members (each 15); and longer-side members disposed along the longer-sides of the flat panel portion (as shown in FIG. 4, for instance).

Fujihata et al. (JP 2001-125667), however, remains silent as to "at least one longer-side engagement member comprising one of a second engaging piece and a second engaging groove provided at said longer side members for engagement with the disk drive body, wherein the number of longer-side engagement members is less than the number of shorter-side engagement members."

Official notice is taken of the fact that it is notoriously old and well known in the art to increase the number of engagement members in the same field of endeavor for



the purpose of enabling a more reliable interconnection between components. Official notice is further taken of the fact that it is notoriously old and well known in the art to routinely optimize the number and location of components in the same field of endeavor. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have had at least one longer-side engagement member comprising one of a second engaging piece and a second engaging groove provided at the longer side members of Fujihata et al. (JP 2001-125667) for engagement with the disk drive body of Fujihata et al. (JP 2001-125667), wherein the number of longer-side engagement members is less than the number of shorter-side engagement members.

The rationale is as follows:

One of ordinary skill in the art would have been motivated to have had at least one longer-side engagement member comprising one of a second engaging piece and a second engaging groove provided at the longer side members of Fujihata et al. (JP 2001-125667) for engagement with the disk drive body of Fujihata et al. (JP 2001-125667) since such enables a more reliable interconnection between the body and the panel.

One of ordinary skill in the art would have been motivated to have had the number of longer-side engagement members be less than the number of shorter-side engagement members since, absent any criticality and/or unexpected results, it is within the level of ordinary skill in the art to routinely optimize the number and location of engagement members.

***Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes "Mechanical Packaging Scheme With Considerations for Maximum ESD/EMC Protection, Efficient Cooling And Quiet Office Environment," IBM Technical Disclosure Bulletin, Vol. 33, Iss. 9, Pages 379-383, February 1, 1991, which teaches a disk drive apparatus comprising a body including a front face having an insertion opening for a disk, an upper face substantially parallel to a recording surface of an inserted disk, and side faces extending generally orthogonal with respect to the upper face; and decorative panels covering approximately entire surfaces of the front face, upper face, and side faces, respectively, and being disposed so as to be detachable therefrom.

***Allowable Subject Matter***

11. Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

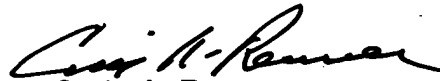
12. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (571) 272-7580. The examiner can normally be reached on Tuesday-Friday 9:00 AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Craig A. Renner  
Primary Examiner  
Art Unit 2627

CAR